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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER
PARK, CHAN S

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
04/15/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
ipa.mail@hp.com
jessica.l.fusek@hp.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>18 December 2008</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2 and 4-45* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *2 and 4-17* is/are allowed.

6)☒ Claim(s) *18-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Applicant's amendment was received on 12/18/08, and has been entered and made of record. Currently, **claims 2 and 4-45** are pending.

Specification

2.   The corrected or substitute specification was received on 12/18/08. The specification is acceptable.

Drawings

3.   The corrected or substitute drawings were received on 12/18/08. The drawings are acceptable.

Response to Arguments

4.   Applicant's arguments with respect to claims 18-45 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claims 18-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 18 recites the limitation of "wherein said printing device configuration settings comprise any of *a resolution setting... and combinations thereof*". The applicant states that the support for this limitation can be found in Paragraph [0005] of the Specification. However, it is noted that the claimed subject matter is not described in the corresponding specification. The Specification states that "*printing device settings may also determine the resolution* or quality of the image being printed and, *consequently*, the amount of ink or toner consumed." In other words, the paragraph appears to state that *the already selected printing device settings* may consequently have a direct impact on the resolution, quality of the image and/or the amount of ink or toner consumed. None of the disclosure, however, describes the printing device configuration setting being a resolution setting *itself*. The Specification is silent as to how the resolution setting (e.g., 400 dpi and 600 dpi) of the printing device is adjusted. Clarification/explanation from the Specification is respectfully requested.

Claims 29 and 44 recite the limitation of "wherein said printing device settings comprise settings associated with _parameters_ selected from the group consisting of _resolution, amount of ink used, amount of toner used_". Again, as noted above, none of the disclosure describes the configuration setting being one of the _resolution, amount of ink used or amount of toner used_.

With respect to claim 45, since the resolution setting is not one of the configuration settings according to the Specification, the step of obtaining the resolution setting associated with the location is not described.

With respect to claim 26, the claim recites the limitation of determining "a source location of said data packet based on said identification information" wherein the identification information is associated with said identifier. However, the corresponding paragraph [0039] discloses that the source location is only determined based on the identifier, not the identification information associated with said identifier. Clarification/explanation from the Specification is respectfully requested.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6.   Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the limitation of "means for configuring said printing device according to settings specified for members of said group". It is noted that the independent claim 29 already includes means for dynamically modifying the

printing device settings based on said identifier. It is unclear if the modified printing

device settings according to claim 29 are configured again based on the settings

specified for members of said group according to claim 43. How are "means for

dynamically modifying" and "means for configuring" different? Clarification/explanation

from the Specification is respectfully requested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 18-21, 24, 28-37, 40, 41, 44 and 45 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Edwards et al. U.S. Patent Application Pub. No.

2004/0212834 (hereinafter Edwards) in view of Colombi et al. U.S. Patent No.

6,511,148 (hereinafter Colombi).

With respect to claim 18, Edwards discloses a printing device comprising:

an input for receiving a print job (S400 in fig. 4); and

a print engine configured to produce a hardcopy from said print job (print engine

220 in fig. 2);

wherein said printing device extracts an identifier from said print job and adjusts

printing device configuration settings based on said identifier (paragraph 42).

Edwards, however, does not explicitly disclose said printing device configuration settings being any of a resolution setting, addition of a feature to be printed with said print job and combination thereof.

Colombi, the same field of endeavor of the adjusting the printing device configuration settings, discloses the printing device wherein the resolution setting of the printing device is adjusted based on the specific characteristics of the printing media (abstract & col. 7, lines 5-8 & col. 8, lines 8-12).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printing device of Edwards to automatically adjusting the printing resolution setting as taught by Colombi.

The suggestion/motivation for doing so would have been to provide a correct resolution setting based the Edwards selected print media type.

Therefore, it would have been obvious to combine Edwards with Colombi to obtain the invention as specified in claim 18.

With respect to claim 19, Edwards discloses the printing device of claim 18, further comprising a database associating identifier with printing device configuration settings (paragraph 42).

With respect to claim 20, Edwards discloses the printing device of claim 18, further comprising a database associating identifiers with source locations and source locations with printing device configuration settings (paragraphs 40 & 42). Note that since the IP _address_ indicates where the device is located in the network, the IP address is construed as the identifier which associates with source location.

With respect to **claim 21**, Edwards discloses the printing device of claim 19, wherein said database is stored in a memory unit of said printing device (mapping module 209 in paragraph 42).

With respect to **claim 24**, Edwards discloses the printing device of claim 18, further comprising a programmable controller programmed to scan headers of a number of data packets for said identifier (paragraph 64).

With respect to **claim 28**, Edwards discloses the printing device of claim 18, further comprising a user interface (operation panel 21 in fig. 2).

With respect to **claim 29**, Edwards discloses a system for configuring a printing device, said system comprising:

means for extracting an identifier from an incoming print job identifying a client submitting said print job (extracting source IP address in paragraph 42); and

means for dynamically modifying printing device settings based on said identifier (paragraph 42).

Edwards, however, does not explicitly disclose said printing device configuration settings being any of a resolution setting, addition of a feature to be printed with said print job and combination thereof.

Colombi, the same field of endeavor of the adjusting the printing device configuration settings, discloses the printing device wherein the resolution setting of the printing device is adjusted based on the specific characteristics of the printing media (abstract & col. 7, lines 5-8 & col. 8, lines 8-12).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printing device of Edwards to automatically adjusting the printing resolution setting as taught by Colombi.

The suggestion/motivation for doing so would have been to provide a correct resolution setting based the Edwards selected print media type.

Therefore, it would have been obvious to combine Edwards with Colombi to obtain the invention as specified in claim 29.

With respect to claim 30, Edwards discloses they system of claim 29, further comprising:

means for scanning data packets of said print job for said identifier (paragraph 64);

means for querying a database to obtain settings for said printing device associated with said identifier (paragraph 52); and

means for configuring said printing device according to said settings associated with said identifier (paragraph 42).

With respect to claim 31, Edwards discloses they system of claim 30, wherein said means for querying a database comprises:

mean for determining a location associated with said identifier (the location of media selection parameter in the mapping module associated with the IP address must be determined in order to retrieve the parameter from the data); and

means for retrieving settings for said printing device associated with said location (paragraph 42).

With respect to claim 32, Edwards discloses they system of claim 30, wherein said means for configuring said printing device occurs automatically when a print job is received (S408 in fig. 4).

With respect to claim 33, Edwards discloses they system of claim 30, wherein said means for scanning comprises searching header data for said identifier (paragraph 64).

With respect to claim 34, Edwards discloses they system of claim 30, further comprising means for storing said identifier in printing device memory (it must be either temporarily or permanently stored in order to make the comparison in paragraph 42).

With respect to claim 35, Edwards discloses they system of claim 30, wherein said database is organized such that each identifier is associated with a set of printing device settings (mapping module storing a plurality of media selection parameters in paragraphs 42).

With respect to claim 36, Edwards discloses they system of claim 30, wherein said database is organized such that each identifier is associated with a client location and a set of printing device settings (paragraphs 40 & 42). Note that since the IP *address* indicates where the device is located in the network, the IP address is construed as the identifier which associates with source location.

With respect to claim 37, Edwards discloses they system of claim 30, wherein said database is stored in printing device memory (mapping module 209 in paragraph 42).

With respect to claim 40, Edwards discloses they system of claim 30, further comprising means for requiring authentication to access said database (logging in to the database in paragraph 53).

With respect to claim 41, Edwards discloses they system of claim 30, wherein said identifier comprises an IP address (paragraph 42).

With respect to claim 44, Edwards discloses a computer readable medium having computer executable instructions thereon which, when executed, cause a printing device to:

scan a print job for an identifier (extracting the source IP address in paragraph 42);

obtain configuration settings associated with said identifier (paragraph 42); and

configure said printing device according to said configuration settings (paragraph 42).

Edwards, however, does not explicitly disclose said printing device configuration settings being any of a resolution setting, addition of a feature to be printed with said print job and combination thereof.

Colombi, the same field of endeavor of the adjusting the printing device configuration settings, discloses the printing device wherein the resolution setting of the printing device is adjusted based on the specific characteristics of the printing media (abstract & col. 7, lines 5-8 & col. 8, lines 8-12).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printing device of Edwards to automatically adjusting the printing resolution setting as taught by Colombi.

The suggestion/motivation for doing so would have been to provide a correct resolution setting based the Edwards selected print media type.

Therefore, it would have been obvious to combine Edwards with Colombi to obtain the invention as specified in claim 44.

With respect to claim 45, Edward discloses the medium, wherein said instructions further cause said printing device to: identify a location of a client device submitting said print job based on said identifier, wherein the step of obtaining configuration settings associated with said identifier comprises obtaining configuration settings associated with said location (paragraphs 40 & 42). Note that since the IP *address* indicates where the device is located in the network, the IP address is construed as the identifier which associates with source location.

8.   Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Edwards and Colombi as applied to claim 19 above, and further in view of Shima U.S. Patent Application No. 2004/0098471.

With respect to claims 22 and 23, Edwards teaches the method of claim 19, but it does not explicitly teach whether said database is stored on a network server or Internet server.

Shima, the same field of endeavor of setting the printing device based on the setting parameter stored in the database, teaches the method of printing parameters in a database stored in a network/Internet server (paragraphs 70-75 & 86).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the server database for storing the printer parameters into the printing system of Edwards.

The suggestion/motivation for doing so would have been to reduce the cost of internal memory and further provide the printing device with most updated printing device settings associated with the identifier.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claims 22 and 23.

9.   Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Edwards and Colombi as applied to claim 18 above, and further in view of Venkatranman et al. U.S. Patent Application No. 2001/0025307 (hereinafter Venkatranman).

With respect to claim 27, Edwards discloses the printing device of claim 18, but it does not explicitly disclose that the printing device comprises an embedded web server.

Venkatranman, the same field of endeavor of the network printing/facsimile device, discloses a printing device having an embedded web server for providing a user with the printing device information on a webpage (fig. 1B & paragraph 27).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the web server of Venkatranman into the printing device of Edwards.

The suggestion/motivation for doing so would have been to provide the printing device information to a user on the network.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 27.

10.   Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Edwards and Colombi as applied to claim 30 above, and further in view of Shima.

With respect to claims 38 and 39, arguments analogous to those presented for claims 22 and 23, are applicable.

11.   Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Edwards and Colombi as applied to claim 29 above, and further in view of Houri U.S. Patent 6,665,715.

With respect to claim 42, Edwards teaches the method of claim 29, wherein said database is organized such that each identifier is associated with a set of printing device settings (paragraph 42).

Edwards, however, does not explicitly disclose means for determining a group to which said client belongs based on said identifier.

Houri, the same field of endeavor of the IP address, discloses a database storing a client location associated with corresponding IP address (fig. 1). Note that the examiner construes a plurality of zones of Houri as a plurality of different groups to which the senders belong.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printer of Edwards to include the database for storing a client location associated with corresponding IP address as taught by Houri.

The suggestion/motivation for doing so would have been to inform the printer where the sender is physically located.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 42.

12.   Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Edwards and Colombi as applied to claim 24 above, and further in view of Houri

With respect to claim 25, arguments analogous to those presented for claim 42, are applicable. Note that Houri discloses a database storing a client location (identification information) associated with corresponding IP address (fig. 1).

Allowable Subject Matter

13.   **Claims 2 and 3-17** are allowed.

Conclusion

14.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/
Primary Examiner, Art Unit 2625

April 6, 2009